

Hayamizu is fed to the paper cutting unit at constant speed (as recited in Applicants' claim 1). On the contrary, it appears that the feed is intermittent. See in particular the passage at column 10, lines 3-8 (quoted in the Amendment Under 37 CFR §1.116).

There is nothing in Hayamizu to suggest changing the speed of the cutting cylinder to achieve the cut at a desired point, or of changing the speed so that the circumferential speed is the same as the (constant) speed of the web at the time of the cut.

Sigel is cited for its disclosure of a web-fed rotary printing press that "is able to accommodate a variety of publications and can accommodate for different changes". However Sigel fails to disclose or suggest any of the above-mentioned limitations with respect to speed changes for controlling the size of the cut sheets. Further, the substitution of the printing press of Sigel for the drawing apparatus of Hayamizu would completely change the principle of the prior art invention being modified, which is impermissible. In re Ratti, 123 USPQ 49 (CCPA 1959). See MPEP 2143.01.

In sum, the combination propounded by the Examiner fails to meet any of the criteria required to establish a *prima facie* case of obviousness, to wit: (1) there must be some suggestion or motivation to modify the reference or to combine the teachings, (2) there must be a reasonable expectation of success, and (3) the references must teach or suggest all the claim limitations. For a more complete explanation of these requirements, see MPEP §§2142 and 2143.

The claims as amended being definite and clearly patentable over the art of record, withdrawal of the rejections and early allowance are solicited. If any objections remain, a call to the undersigned is requested.

If any fees or charges are required at this time in connection with the application,
they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

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